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[PATENT]

AUG 26 2004

BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial Number:10/646,592
Filed:08/22/2003
Art Unit:3641
Today's Date: August 26, 2004

Examiner:Semunegus
Atty Dkt:ROBET03/01
Due Date:05/24/2004

Restriction Response

Assistant Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In Response to the Restriction Requirement dated 07/26/2004 in the above matter, please consider the election with traverse and argument for reconsideration herein.

Election

In response to the Restriction Requirement in the above case dated 07/26/2004, the applicant hereby elects the Invention of Group II claims 20-23, which have already been allowed in the Office Action dated 2/24/2004, **the present election made with exceptional traverse**, for reasons stated as follows:

Restriction after Examination on the Merits is not Necessary in this Case
as it does not represent a "serious burden" on the Office,
as required under MPEP 811 et seq.

Facts of the Case

The Examiner issued a first Office Action on the merits on 2/24/2004 examining all 24 claims as filed. The Office Action was made after the Examiner conducted an international search, reviewed Applicants disclosures embodied in its Information Disclosure Statement, and issued the Office Action which included prosecution of all of the claims in the case as filed, i.e. those now subject the Restriction Requirement. In said Office Action, the Examiner allowed claims 14-24,

which included both apparatus as well as all of the method claims in the case.

Further, claims 4-13 were objected to as being dependent upon a rejected base claim, but were indicated as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Thus, the only real controversy remaining in the case was with regard to claims 1-3, which had been objected to under 102(b) citing Lee '274.

In direct reply to the Examiner's Office Action and indicated requirements, Applicant filed a Response dated 05/06/2004, wherein claims 1 and 2 were amended to accommodate the Examiner by further differentiating said claims from Lee '274 in light of the Examiner's comments.

The only other amendment to the claims in said Response was minor form amendment, and the addition of two simple dependent apparatus claims. These new claims are not believed to require new searching or any substantive further examination, and the Applicant kept the Response simple and to the point to accommodate the Examiner.

The undersigned fully anticipated that all of the issues indicated by the Examiner had been responded to in the last Response, and that a Notice of Allowance was to be the next document to be received in this case.

The undersigned was therefore surprised to find the Examiner now imposing a restriction requirement on the present case, after the first Office Action on the Merits, after a most of the claims had been allowed (claims 14-24) or indicated as allowable with amendment (claims 4-13), and certainly there has been nothing done by the Applicant to necessitate such a requirement.

It is reiterated that the amendment to claims 1-2 was done to accommodate the Examiner in getting the remaining claims 1-13 allowable, and would not have otherwise been made.

Applicable Law and Policy

According to the MPEP (810.02), it is the policy of the Patent Office to issue the Restriction response before action on the merits, not after. In the present case, the Examiner has already done the search and issued findings, allowed (or indicated allowable) all but one apparatus claim (claim

1) and two claims dependent thereon (claims 2-3). Further, the Applicant in Response amended only claims 1 and 2 to accommodate the Examiner, and did not add any new issues to the case which necessitated the present Restriction Response.

Whether to issue the Restriction Requirement or not is at the discretion of the office (MPEP 803). The time for making the requirement is before the action on the merits (810.02), unless amendment in the Response necessitated the Requirement, which is not the case here.

Section 811 (last paragraph) of the MPEP addresses particularly the "Time for Making Requirement" of Restriction Requirements, indicating:

"Before making a restriction response after the first action on the merits, the examiner will consider whether there will be a serious burden if restriction is not required." (Emphasis ours)

It is respectfully submitted that, on this basis alone, restriction on the present case should be reconsidered, as the Examiner has already done the international search and has prosecuted the claims in the case on the merits already, and has allowed apparatus and method claims 14-24, and indicated allowable with amendment 4-13, and that, accordingly, only a single dependent claim is still in play.

The Examiner's Restriction Requirement required election of one of Group I comprising the apparatus claims in the case, and Group II, comprising the Method Claims. However, as earlier noted, the method claims have already been allowed, and most of the claims of Group II have already been allowed or indicated as allowable. Accordingly, there is can be not "serious burden" on the Examiner if restriction is not required in the present case.

On the contrary, because prosecution on the merits has already taken place and the case largely allowed or indicated allowable, it would be burdensome on the patent office to require restriction at this late date, requiring that the office duplicate the prosecution on the merits for

that which has already been done in this case.

Further, restriction in the present case at this point and time would be a "serious burden" on the applicant in the present case. Not only will Restriction require duplicative efforts for subject matter already prosecuted, it will result in significantly greater costs for the applicant which we believe are unnecessary, wasteful, and prejudicial. It is reiterated that the Method Claims of Group II have already been allowed; how can these allowed claims be then made a separate and distinct group for Restriction at this late date?

Further, applicant is in the process of developing potential Licensees for the technologies embodied in these patents, and this unexpected Requirement for Restriction, after prosecution on the merits and allowance of much of the case, could hinder further commercialization of the system.

It is reiterated that Claims 14-24 have already been allowed, claims 4-13 have been indicated as allowable, and we believe that the amendment to claims 1 and 2 has made the remaining claims allowable in accordance with the Examiner's earlier guidance, so we are of the opinion that prosecution is almost complete, and to finish the case in its present form does not place a "serious burden" upon the Examiner under these circumstances, as is required by MPEP 811.

Thus, under MPEP 811 and for the other reasons stated above, the case should be continued with prosecution of the claims already prosecuted on the merits, and the applicant and the undersigned request reconsideration of this requirement for restriction.

**Restriction is improper as the Claims represent a "common inventive effort"
and do not require a different field of search**

As indicated in the MPEP at 808.02:

"Where the related inventions as claimed are shown to be distinct under the criteria of MPEP 806.05(C - D), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

(1) Separate classification thereof:

This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(2) A separate status in the art when they are classifiable together:

Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(3) A different field of search:

Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.” (Emphasis ours)

The Examiner has alleged that “In the instant case increasing the capacity of a firearm can be accomplished by having a compressible wad.”, but he offers no explanation how that is relevant, distinct, or distinguishable from the present claims in the case at hand.

The present case only has two independent claims, apparatus claim 1 and method claim 20:

- Apparatus claim 1 (Group I) specifying *“a shot shell having... a compressible portion situated at said first end of said shot shell..”*

- Method claim 20 (Group II) having as one of its four simple steps (a.) that of *“providing a shot shell having a length and a first end having a compressible portion”*

Both claims specify a shot shell having a first end having a compressible portion. Once again, the Examiner alleged that “In the instant case increasing the capacity of a firearm can be accomplished by having a compressible wad.”, yet both the method and apparatus claims specify important commonalities of structure.

Thus, it would appear that the inventions are not "distinct" in the manner asserted by the Examiner.

Further, the Examiner alleges that claims 20-23 are drawn to a separate classification than the other claims, stating said claims relate to "a method of increasing the capacity of a firearm, classified in class 86, subclass 44."

However, our review of Class 86, subclass 44 indicates that it reads "Shell holders" defined as "devices for holding shells in convenient position for loading"¹, which apparatus class would not appear to be clearly applicable to independent method claim 20, which relates not to an "shell holder" apparatus or device configuration as apparently embodied in Class 86, subclass 44, but to rather a method of increasing the capacity of a firearm utilizing a shot shell having a length and a first end having a compressible portion, as set forth in said claim.

Thus, there has been no showing by the examiner that "each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification." as is required under MPEP 808.02.

In the present case, it is submitted that the claims of the present application relate to a common inventive effort, which have already been prosecuted on the merits.

As stated in MPEP 806.05(c): "If there is no evidence that combination A Bsp is patentable without the details of Bsp, restriction should not be required. Where the relationship between the claims is such that the separately claimed subcombination Bsp constitutes the essential distinguishing feature of the combination A Bsp as claimed, the inventions are not distinct and a requirement for restriction must not be

¹This class is classified under Class 34 "Ammunition Loading", defined as "Machines and devices not otherwise classifiable for loading or reloading fixed ammunition for small-arms and ordnance", likewise certainly not clearly falling under the method of Group II.

made, even though the subcombination has separate utility."

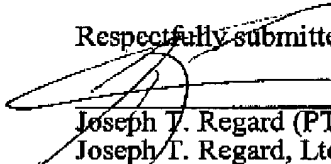
It is respectfully submitted that no such evidence has been shown, and as such, as stated above, "restriction should not be required."

The remaining Examination of the Claims 1-26 should not present an "undue burden" upon the Examiner, especially considering that claims 14-24 have already been allowed, claims 3-13 have already been indicated as allowable, and the earlier Response in our opinion cured the remaining issues in the case as set forth in the last Office Action, and accordingly and reconsideration of the Restriction Requirement is thus respectfully requested. Further, even if they had not been already examined on the merits and already largely found allowable, their commonalities in structure and classification demand examination without restriction.

Also, the undersigned respectfully requests that the Examiner remember the undue burden which will be caused upon the applicant should restriction be required in the present case, in light of the prosecution on the merits already having been substantially undertaken.

If additional issues remain, and the Examiner is of the opinion that same could be resolved by telephone amendment, the undersigned respectfully requests same at (985) 845-0000.

Respectfully submitted,


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CERTIFICATE OF FAXING

I HEREBY CERTIFY that the present document was faxed to the Commissioner for Patents, Central fax number 703 872-9306, this 26 day of AUGUST, 2004.


Joseph T. Regard (PTO Reg 34,907)